

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: BAMERT-1 PCT

SERIAL NO: 09/856,390

EXAMINER: Andrew Wright

FILED: May 22, 2001

GROUP: 3617

TITLE: DEVICE FOR HOLDING THE LOG TRANSMITTER OF A BOAT
SPEEDOMETER

PETITION UNDER RULE 136(a) AND RULE 17(a)(2)

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicants petition the Commissioner of Patents and Trademarks, under Rule 136(a), to extend the time for response to the Office Action dated, June 16, 2004 for two months, from September 16, 2004 to November 16, 2004. A check in the amount of \$215.00 is enclosed to cover the fee for a two month extension of time for a small entity.

The Commissioner is hereby authorized to charge any additionally required fee, or to credit any overpayment, to our Deposit Account No. 03-2468.

Respectfully submitted,
BAMERT-1

By:

Allison C. Collard, Reg No. 22,532

Edward R. Freedman, Reg. No. 26,048

William C. Collard Reg No. 38,411

Elizabeth Collard Richter Reg. No. 35,103

COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

Enclosure: check for \$215.00

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 29, 2004

Maria Guastella

Maria Guastella

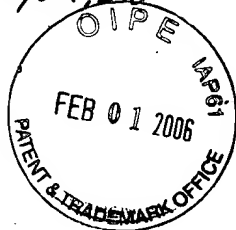
22



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,390	5/22/2001		BARNETT-1 PCT	8010



EXAMINER

ART UNIT	PAPER NUMBER
3617	

DATE MAILED: 11/1/2005

NOTICE UNDER 37 CFR 1.251 - Pending Application

☐ The file of the above-identified application cannot be located after a reasonable search. Therefore, the Office is initiating the reconstruction of the file of the above-identified application pursuant to the provisions of 37 CFR 1.251.

Applicant is given a period of **THREE (3) MONTHS** from the mailing date of this notice within which to provide a copy of applicant's record (if any) of all of the correspondence between the Office and applicant for the above-identified application (except for U.S. patent documents), a list of such correspondence, and a statement that the copy is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and whether applicant is aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

☐ The following paper(s) pertaining to the above-identified application cannot be located after a reasonable search:

PLEASE SUPPLY A COPY OF THE FILE EXCLUDING DOCUMENT ORIGINALLY FILED
Therefore, the Office is initiating the reconstruction of such paper(s) pursuant to the provisions of 37 CFR 1.251.

Applicant is given a period of **THREE (3) MONTHS** from the mailing date of this notice within which to provide a copy of the paper(s) listed above and a statement that the copy of such paper(s) is a complete and accurate copy of applicant's record of such paper(s).

Alternatively, applicant may reply to this notice by producing applicant's record (if any) of all of the correspondence between the Office and the applicant for the above-identified application for the Office to copy (except for U.S. patent documents), and provide a statement that the papers produced by applicant are applicant's complete record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), whether applicant is aware of any correspondence between the Office and the applicant for the above-identified application that is not among applicant's records. Such records must be brought to the Customer Service Center in the Office of Initial Patent Examination (Crystal Plaza 2, 2011 South Clark Place, Arlington, VA 22202).

If applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application (or any copy of the paper(s) listed above), applicant must reply to this notice by providing a statement that applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application.

Failure to reply to this notice in a timely manner will result in abandonment of the above-identified application. The three-month period for reply to this notice may be extended (up to a maximum of six months) under the provisions of 37 CFR 1.136(a). However, failure to reply within this three-month period will result in a reduction of any patent term adjustment. See 37 CFR 1.704(b).

☒ A printout from PALM of the contents of the file of the above-identified application is included with this notice.
Direct the reply to this notice to:

Box Reconstruction
United States Patent and Trademark Office
ALEXANDRIA, VA 22313

JACKIE WALDO

HEAD SUPERVISORY, LEGAL INSTRUMENTS EXAMINER

Direct questions concerning this notice to:



UNITED STATES PATENT AND TRADEMARK OFFICE

cpt

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,390	05/22/2001	Hans Joachim Bamert	BAMERT-1 PCT	8010

7590 11/01/2005
COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, NY 11576-1696

EXAMINER
WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
3617	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



In re Application of: Hans Joachim BAMERT

Application No.:) 09/856,390

Filing Date: May 22, 2001

Title: DEVICE FOR HOLDING THE LOG TRANSMITTER
OF A BOAT

Direct to: Box Reconstruction
United States Patent and Trademark Office
Washington, DC 20231

NOTICE UNDER 37 CFR 1.251 - Pending Application**Statement (check the appropriate box):**

☒ The copy submitted with this reply is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

☐ The copy of the paper(s) listed in the notice under 37 CFR 1.251 is/are a complete and accurate copy of applicant's record of such paper(s).

☐ The papers produced by applicant are applicant's complete record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and the applicant for the above-identified application that is not among applicant's records.

☐ Applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application.

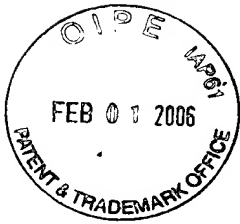
Feb. 1, 2006

Date

Signature

Edward R. Freedman
Typed or printed name**A copy of this notice should be returned with the reply.**

Burden Hour Statement: This collection of information is required by 37 CFR 1.251. The information is used by the public to reply to a request for copies of correspondence between the applicant and the USPTO in order to reconstruct an application file. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 60 minutes to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: HANS-JOACHIM BAMERT-1 PCT
SERIAL NO.: 09/856,390 GROUP: 3617
FILED: May 22, 2001
FOR: DEVICE FOR HOLDING THE LOG TRANSMITTER OF A
BOAT SPEEDOMETER

PETITION

Mail Stop PCT LEGAL ADMINISTRATION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby respectfully petitions the PTO from the decision of "Filing of 35 U.S.C. 111 Application", dated April 8, 2003, and the Notification stating "that the papers are considered filed under 35 USC §111(a)". It is believed that this filing is properly a filing under 35 U.S.C. 371.

A filing under 35 USC §111 would be a very serious detriment to the right of applicant, since it is possible that the application filed under Section 111 would be rejected based upon applicant's own published priority application. The applicant never intended to prejudice his own rights under US patent law. It would be inconsistent with 35 U.S.C. 120 to deny applicant his right to have his national stage patent application denied pendency in the U.S. This is because 35 U.S.C. 120 refers to 35 U.S.C. 363, which makes intentional


18

applications a part of a claim of continuing patent applications in the U.S. Thus, 35 U.S.C. 120 is not inconsistent with a filing under 35 U.S.C. 371.

A filing under 35 U.S.C. §371 is respectfully requested. Please charge any additional fees therefore to deposit account 03-2468.

Respectfully submitted,

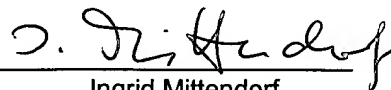
HANS JOACHIM BAMERT

By 
Allison C. Collard, Reg. No. 22,532
Edward R. Freedman, Reg. No. 26,048

1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

Enclosure: Form PCT/DO/EO/911
Copy of Notification

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP PCT Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 1, 2003.


Ingrid Mittendorf

ERF:im

28 SEP 2004



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576



In re Application of
BAMERT, Hans Joachim
Application No.: 09/856,390
Filing Date: 22 May 2001
Attorney Docket No.: BAMERT-1 PCT
For: DEVICE FOR HOLDING THE LOG
TRANSMITTER OF A BOAT
SPEEDOMETER

DECISION

This decision is in response to applicant's "Petition" filed in the United States Patent and Trademark Office on 04 August 2003.

BACKGROUND

On 17 October 2000, applicant filed international application PCT/EP00/10189. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 April 2001. The twenty month period for paying the basic national fee in the United States expired on 21 June 2001.

On 22 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a preliminary amendment. The preliminary amendment amends the specification to "claim priority under 35 U.S.C. §120 of PCT/EP00/10189, filed on 17 October 2000."

On 13 July 2001, USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the translation was defective for the reasons indicated on the attached Notice of Defective Translation (Form PCT/DO/EO/913). The Notice of Defective Translation indicated that the number of claims in the International Application and the number of claims in the translations were not the same.

On 13 September 2001, applicant filed "Response to Notification of Missing Requirements Under 35 USC 371," accompanied by fifteen claims in German and a translation of those claims.

On 10 October 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective as the number of claims in the International Application and the number of claims in the translation were not the same and that the processing fee for late furnishing of the translation and a translation of the application were required.

20

On 13 November 2001, applicant submitted "Response to Notification of Defective Response," accompanied by a translation.

On 05 December 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective because it was marked up.

On 05 June 2002, applicant submitted "Petition Under Section 711.03(c) - Section 2 and Response to Notification of Defective Response," accompanied by a translation and docket printouts.

On 08 July 2002, the Office mailed "Notification" indicating that the application contained conflicting instruction and would be processed as a 35 U.S.C. §111(a) application.

On 04 August 2003, applicant submitted the instant petition.

DISCUSSION

The transmittal letter (Form PTO-1390) filed on 22 May 2001 identified the application as "a filing under 35 U.S.C. 371." However, the transmittal letter (bottom margin) and the preliminary amendment claim benefit under 35 U.S.C. §120 to the PCT application. Applicant's benefit claim under §120 to the international application is inconsistent with a filing under U.S.C. §371. Since applicant gave conflicting instructions, the papers were considered filed under 35 U.S.C. §111(a).

Applicant argues that the 35 U.S.C. §120 claim is not a conflicting instruction. 35 U.S.C. §120 allows for claims to prior filed applications, by either 111(a) filings or international applications. Applicant claimed priority to the international application as a prior filed application. By doing so, applicant indicated that the 22 May 2001 submission was a different application from the international application filed 17 October 2000. A 35 U.S.C. 371 application is the international application and does not claim priority to itself.

Applicant argues that its 111(a) application will be rejected based on applicant's published international application. This is not the case. Applicant is entitled to claim benefit under 35 U.S.C. §120 and §365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/856,390) and the international application (PCT/EP00/10189) designating the United States were copending on 22 May 2001.

CONCLUSION

For the above reasons, the petition submitted 04 August 2003 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper

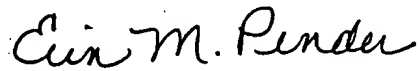
response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration. As of 01 October 2004, the undersigned may be reached at 571-272-3292 and PCT Legal Administration's facsimile number will be 571-273-0459.

This application is being returned to Art Unit 3617 for further processing



Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration



Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: HANS JOACHIM BAMERT PCT
PCT: PCT/EP00/10189 FILED: OCTOBER 17, 2000
SER. NO. 09/856,390 GROUP:
FILED: MAY 22, 2001
FOR: DEVICE FOR HOLDING THE LOG TRANSMITTER OF A BOAT
SPEEDOMETER

PETITION UNDER SECTION 711.03c - SECTION 2
AND RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE

BOX PCT
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Since the official filing receipt in the above case was still outstanding, we recently called the US PTO to inquire. To our astonishment, we were told that a Notification of Defective Response dated December 5, 2001, had been mailed to us. It is hereby certified that a careful search of our file did not yield such a Notification dated December 5, 2001. Upon our request, a copy of this Notification was faxed to us by Mr. Greg Vidovich on May 31, 2002.

As proof that the undersigned never received this Notice, enclosed are pages of the undersigned's docket dated December 6 and December 18, 2001, showing that no entry was made under the due date of January 5, 2002 since the Notice never was received.

In order to comply with this Notice, applicant encloses a copy of the literal translation of the PCT application in which the dependency of original claim 11 has been corrected to comply with the original German text. However, further prosecution of this case should be based on the Substitute Specification and new claims 21-40, mailed to the US PTO on January 4, 2002 in a "Further Preliminary Amendment".

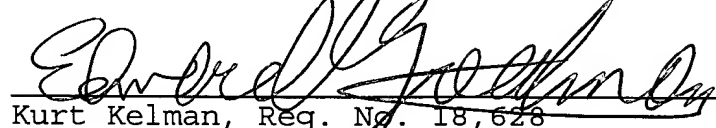
14

Copy FAX'd to [unclear]
703- [unclear] - 6219

If there is any fee associated therewith, please charge deposit account 03-2468.

Respectfully submitted,

HANS JOACHIM BAMERT



Kurt Kelman, Reg. No. 18,628

Allison C. Collard, Reg. No. 22,532

Edward R. Freedman, Reg. No. 26,048

COLLARD & ROE, P.C.

1077 Northern Boulevard Attorneys for Applicants

Roslyn, New York 11576

(516) 365-9802

Enclosure: Copy of Notification of Defective Response of 12/5/01
Complete copy of literal English translation of PCT
application, having the defect corrected

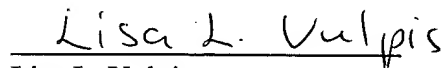
Copies of docket pages from Dec. 6 and Dec. 18, 2001.

BOX PCT APPLICATION

EXPRESS MAIL NO. EL 871 453 522 US

Date of Deposit June 5, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above, and is addressed to the Asst. Commissioner for Patents, Washington, DC 20231.


Lisa L. Vulpis



08 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov



ECR

Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

In re Application of
BAMERT, Hans Joachim
Application No.: 09/856,390
Filing Date: 22 May 2001
Attorney Docket No.: BAMERT-1 PCT
For: DEVICE FOR HOLDING THE LOG
TRANSMITTER OF A BOAT
SPEEDOMETER

NOTIFICATION

This application is before the Office of PCT Legal Administration for consideration of matters arising under 35 U.S.C. §371.

BACKGROUND

On 17 October 2000, applicant filed international application PCT/EP00/10189. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 April 2001. The twenty month period for paying the basic national fee in the United States expired on 21 June 2001.

On 22 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a preliminary amendment. The preliminary amendment amends the specification to "claim priority under 35 U.S.C. §120 of PCT/EP00/10189, filed on 17 October 2000."

On 13 July 2001, USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the translation was defective for the reasons indicated on the attached Notice of Defective Translation (Form PCT/DO/EO/913). The Notice of Defective Translation indicated that the number of claims in the International Application and the number of claims in the translations were not the same.

On 13 September 2001, applicant filed "Response to Notification of Missing Requirements Under 35 USC 371," accompanied by fifteen claims in German and a translation of those claims.

On 10 October 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective as the number of claims in the International Application and the number of claims in the translation were not the same and that the processing fee for late furnishing of the translation and a translation of the application were required.

15

On 13 November 2001, applicant submitted "Response to Notification of Defective Response," accompanied by a translation.

On 05 December 2001, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the current translation was defective because it was marked up.

On 05 June 2002, applicant submitted "Petition Under Section 711.03(c) - Section 2 and Response to Notification of Defective Response," accompanied by a translation and docket printouts.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

→ The transmittal letter (Form PTO-1390) filed on 22 May 2001 identified the application as "a filing under 35 U.S.C. 371." However, the transmittal letter (bottom margin) and the preliminary amendment claim benefit under 35 U.S.C. §120 to the PCT application. Applicant's benefit claim under §120 to the international application is inconsistent with a filing under U.S.C. §371. Since applicant has given conflicting instructions, the papers are considered filed under 35 U.S.C. §111(a).

CONCLUSION

For the above reasons, the petition submitted on 05 June 2002 is **DISMISSED AS MOOT.**

The Notification of Missing Requirements mailed on 13 July 2001 is hereby **VACATED.**

The Notifications of Defective Response mailed on 10 October 2001 and 05 December 2001 are hereby **VACATED**.


X This application is accepted as an application filed under 35 U.S.C. §111(a) with a filing date of 22 May 2001.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the International Division for processing in accordance with this decision, that is for (1) removal of the papers communicated from the International Bureau to the United States Patent and Trademark Office concerning international application PCT/EP00/10189, (2) correction of information in PALM (computer database) and (3) correction of fees. Afterwards, the application will be forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. §111(a) with a filing date of **22 May 2001**.



Boris Milef
PCT Legal Examiner
PCT Legal Administration



Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459